

### **REMARKS**

Claims 1-42 are pending in the present application. Claims 1-11, 13-21, 26, 30-34, and 37-41 are amended. The amendments to the claims are unrelated to the rejections cited by the examiner. Reconsideration of the claims is respectfully requested.

Amendments to the specification overcome the examiner's objection. The amendments to the specification add no new matter.

The examiner states that the documents in the information disclosure statement were not considered. Applicants note that the listed documents are not prior art because the listed dates of publication are after the filing date of this application.

#### **I. Objection to the Specification**

The examiner objects to the specification because it allegedly contains embedded hyperlinks or other forms of browser-executable code on page 13. Applicants have amended the specification accordingly, thereby overcoming the objection.

#### **II. 35 U.S.C. § 102, Anticipation**

The examiner rejects claims 1-32 and 34-42 under 35 U.S.C. § 102(e) as anticipated by *Welter et al.*, Testing Web Sites, U.S. Patent 6,631,408 (Oct. 7, 2003). This rejection is respectfully traversed.

##### **II.A Rejection of Claim 1**

Regarding claim 1, the examiner asserts that:

Claim 1. A method of identifying web sites (column 2, lines 26-36) comprising: identifying at least one functional characteristic to be tested (column 2, lines 34-47); retrieving content for a web site (column 4, lines 44-60); testing the content of the web site for the presence of the at least one functional characteristic (column 2, lines 26-36); and storing the results of the testing of the content of the web site (column 2, lines 26-36).

Office Action of March 9, 2005, p.3.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference,

arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

Claim 1 reads as follows:

1. A method of identifying web sites, comprising:  
identifying at least one functional characteristic to be tested;  
retrieving content for a web site;  
testing the content of the web site for the presence of the at least one functional characteristic; and  
storing the results of the testing of the content of the web site.

*Welter* does not anticipate claim 1 because *Welter* does not show each and every feature of claim 1 in the same arrangement. For example, the steps of "identifying at least one functional characteristic to be tested" and "testing the content of the web site for the presence of the at least one functional characteristic" are not disclosed in *Welter*.

With regard to the step of identifying at least one functional characteristic, the examiner believes that *Welter* teaches this feature, citing the following portion of *Welter*:

The operation of formulating a test configuration file preferably includes sending HTML comprising a blank testing form to a web browser, receiving HTTP from the web browser as a submission from the testing form and developing the test configuration file from the HTTP received from the web browser. In this fashion, a standard web browser can be used as the interface between the test operator and the testing software. Preferably, the web browser can also be used to edit test configuration file that has already been developed.

*Welter*, col. 2, ll. 37-47.

As can be seen, this portion of *Welter* does not show identifying at least one functional characteristic as recited in claim 1. In *Welter*, a test configuration file is formulated by sending an HTML document including a blank testing form, receiving the

form, and developing a test configuration file. The web browser can be used to edit the test configuration file. These different steps do not teach or disclose identifying a functional characteristic of a web site to be tested, as recited in claim 1.

Instead, the cited section of *Welter* generally teaches a process for generating a test configuration file without providing any teaching or disclosure as to what type of testing is to occur while testing a web site for errors using this configuration file. *Welter* does not teach any sort of identifying in the cited section. Rather, this section describes how to create a test configuration file without providing details of the type of testing that is to occur. *Welter* is silent with respect to a feature of identifying at least one functional characteristic as recited in claim 1. As a result, each and every feature of the presently claim invention in claim 1 is not taught by *Welter*.

As another example, *Welter* also does not show testing the content of the web site for the presence of the at least one functional characteristic, as recited in claim 1. In stating that this feature is taught by *Welter*, the examiner cites to the following portion of *Welter*:

A method for testing a web site in accordance with the present invention formulates a test configuration file comprising a series of test inquiries for a web site, initiates an HTTP communication to form a connection with the web site, and repetitively communicates with the web site. More particularly, the method repetitively communicates with the web site by receiving HTML from the web site, analyzing HTML for errors and storing the results in the database, and then formulating a new HTTP communication to the web site based upon the received HTML and the test configuration file.

*Welter*, col. 2, ll. 26-36.

This portion of *Welter* describes a method of testing a website for errors. The disclosed process includes formulating a test configuration file having a series of test inquiries and repetitively communicating with a web site to be tested. Based on the received HTML and the test configuration file, the process formulates a new HTTP communication. Although *Welter* describes testing a website for errors, *Welter* does not describe testing the content of a web site for the presence of a functional characteristic as recited in claim 1. Nothing in the cited paragraph shows testing a web site for the at least

one functional characteristic. An error is not a functional characteristic. Therefore, *Welter* does not teach each and every feature of claim 1.

## **II.B Rejection of Claims 2-30 and 40-42**

Independent claims 11 and 21 contain similar features directed to functional characteristics. Accordingly, *Welter* does not anticipate these claims for the reasons given above. Furthermore, because claims 2-10, 12-20, 22-30, and 40-42 depend from claims 1, 11, and 21 accordingly, the same distinctions between *Welter* and claim 1 can be made for these claims. Additionally, claims 2-10, 12-20, 22-30, and 40-42 claim other additional combinations of features not taught or disclosed by the reference.

## **II.C Rejection of Claim 31**

Regarding claim 31, the examiner states as follows:

Claim 31. A method of identifying web sites (column 5, lines 25-33), comprising: receiving a search request including a designation of one or more web site functional characteristics; searching a web site functional characteristics database (column 6, line 16 and column 5, lines 5-10) based on the search request; and returning results of searching the web site functional characteristics database to thereby identify zero or more web sites having or not having the designated one or more web site functional characteristics (column 6, line 16 and 60-67).

Office Action of March 9, 2005, pp. 12-13.

Claim 31 is as follows:

31. A method of identifying web sites, comprising:  
receiving a search request including a designation of one or more web site functional characteristics;  
searching a web site functional characteristics database based on the search request; and  
returning results of searching the web site functional characteristics database to thereby identify zero or more web sites having or not having the designated one or more web site functional characteristics.

*Welter* does not anticipate claim 31 because *Welter* does not show each and every feature of claim 31 in the same arrangement. In this case, *Welter* does not show any of the steps of claim 31.

The examiner believes otherwise, citing various portions of *Welter* for support. Applicants address each of these citations in turn. With regard to the step of "receiving a search request," the examiner cites the following portion of *Welter*:

*If, on the other hand, operation 52 determines that the user wishes to edit a test configuration file, a "Fig. Form" is sent via HTTP/HTML to the browser in an operation 66. The edit information is received from the browser in operation 68 in the form of HTTP. An operation 70 then creates the edited test configuration file, and process control is returned to operation 52.*

...

*In FIGS. 3A-3E, a number of exemplary web pages are presented to describe the process of the present invention. It should be noted this is just one example of a virtually unlimited number of web pages and web page combinations which can be tested by the process of the present invention.*

*In FIG. 3A an illustrated web page 78 is the "home page" of Freshwater Software, Inc. Among other features, it includes a series of buttons 80 which form "links" to other web pages. In particular, a button 82 makes a link to a "search" web page.*

...

*Under step1 type, a pull down menu 102 is provided which has the entry of URL. This is because the step1 reference 104 must always be a URL to act as a starting point for the process. The URL can be the URL of a web site home page, or of any other web page. It is merely a starting point for the test. The step2 type pull down window 106 is a "link" to a button labeled "Search" as in a step2 reference 108. Step3 type is selected to be "Form" in pull down menu 110, while the entry field 112 of step3 reference is left blank. Step4 type in pull down window 114 is "URL", while the URL in field 116 is input as "http://www.macromedia.com." An update box 118 is set at every 10 minutes an optional title that would appear in the monitor table from the field 120 is left blank. A button 122 is activated if the monitor is to be created from this data.*

*Welter*, col. 5, ll. 5-10 and 25-33 and col. 6, ll.6-20 (emphasis provided to show portions cited by the examiner).

As can be seen, these portions of *Welter* do not show receiving a search request including a designation of one or more web site functional characteristics as recited in claim 31. As described above, a test configuration file is formulated in *Welter* by sending an HTML document including a blank testing form, receiving the form, and developing a test configuration file. The web browser can be used to edit the test configuration file.

These different steps do not teach or receiving a search request including a designation of one or more web site functional characteristics, as recited in claim 31.

Instead, the cited section of *Welter* generally teaches a process for editing and using the test configuration file. *Welter* does not teach any sort of receiving a search request, including a designation of one or more web site functional characteristics. Rather, this section describes how to edit and use a test configuration file. *Welter* is silent with respect to the feature of receiving a search request as recited in claim 31. As a result, each and every feature of the presently claim invention in claim 31 is not taught by *Welter*.

With regard to the step of "searching a web site functional characteristics database based on the search request," the examiner cites column 6, line 16 and column 5, lines 5-10 of *Welter* for the assertion that *Welter* shows this step. These portions of *Welter* are quoted above. Again, *Welter* discloses editing and using the configuration file, not searching a web site functional characteristics database. Even if the configuration file could be considered a database, *Welter* discloses searching a *web page* for errors based on the configuration file, not searching the configuration file itself. In addition, the configuration file is not a web site functional characteristics database as claimed in claim 31. Instead, the configuration file contains information regarding the types of errors that should be tested in the web site. *Welter* is specific with regard to this function of the configuration file. See *Welter*, col. 7, ll. 19-40.

*Welter* discloses that the configuration file specifies the parameters of the test. The configuration file does not maintain a database of functional characteristics of the web site in question. Thus, the configuration file is distinct from a functional characteristics database, as claimed in claim 31. Accordingly, *Welter* does not anticipate claim 31.

With regard to the step of "returning results of searching the web site functional characteristics database to thereby identify zero or more web sites having or not having the designated one or more web site functional characteristics," the examiner cites the following portions of *Welter* for the proposition that *Welter* shows this step:

URL in field 116 is input as "http://www.macromedia.com."

...

A pull down menu 152 is used for the list order for the monitors. *As noted previously, any number of monitor objects can be created to test multiple web sites or to test the same web site in multiple ways. The "list order" indicates where on a list of monitor objects the current monitor object is to be added. In this instance, the list order is "last". Other list orders include "first", "middle", etc.*

*The web page 96 also includes an "Error" pull down menu 154 and a "Warning" pull down menu 156. In this instance, an error is set if the status is not equal to 200, which is a default and a warning will occur if status is equal to -994, which is also a default. A status 200 means "good" and is associated with the status field of an HTTP request. The -994 default on the warning is an arbitrary internal coding indicating a software problem. For example, if the software takes more than 10 seconds to respond, a status -994 may be provided.*

*Welter*, col. 6, l. 16 and col. 6, l. 60 through col. 7, l. 8 (emphasis added to show portions cited by the examiner; the context of col. 6, l. 16 is cited above).

The cited portion of *Welter* discloses using a number of monitor objects to test multiple web sites. Thus, multiple web sites are tested for errors in the manner described above. However, *Welter* does not show, in the cited portions or otherwise, to identify zero or more websites having the designated one or more functional web-site characteristics, in the manner claimed. Testing for errors based on a configuration file is not the same as identifying websites having the designated functional web site characteristics. For example, *Welter* never shows or discloses that a particular functional characteristic be displayed if identified; only that an error be returned if a test results in an error.

#### **II.D Rejection of Claims 32-34**

As shown above, *Welter* discloses none of the features of claim 31. Hence, *Welter* does not anticipate claim 31. For similar reasons, *Welter* does not anticipate claims 32-34, at least by virtue of their dependency on claim 31.

#### **II.E Rejection of Claim 35**

Regarding claim 35, the examiner states as follows:

Claim 35. A data structure having entries corresponding to web sites for used by a computing device to identify web sites (column

3, lines 1-25) based on functional characteristics, each entry comprising: web site identifier field for identifying a web site (column 6, lines 59-65); and one or more functional characteristic fields for identifying functional characteristics of the web site identified in the web site identifier field (column 7, lines 9-18 with figure 5).

Office Action of March 9, 2005, pp. 13-14.

Claim 35 is as follows:

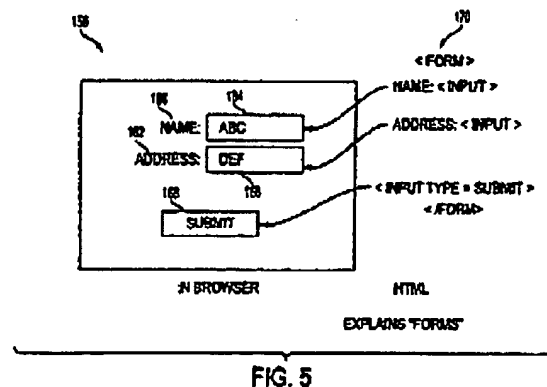
35. A data structure having entries corresponding to web sites for use by a computing device to identify web sites based on functional characteristics, each entry comprising:  
a web site identifier field for identifying a web site; and  
one or more functional characteristic fields for identifying functional characteristics of the web site identified in the web site identifier field.

*Welter* does not anticipate claim 35 because *Welter* does not show each and every feature of claim 35 in the same arrangement. In this case, *Welter* does not show one or more functional characteristic fields for identifying functional characteristics of the web site identified in the web site identifier field, as claimed.

The examiner believes otherwise, pointing to the following portions of *Welter*:

In FIG. 5, a form 158 is displayed to illustrate some of the concepts of the present invention. The form includes a first label 160 "name:" and a second label 162 called "address:". Associated with the labels 160 and 162 are entry fields 164 and 166, respectively. Also associated with the form is a "submit" button 168. The form 158 is as it may appear within a browser window. The HTML which creates the form 158 in the browser window is shown generally at 170. The use of HTML 170 to create a form 158 in a browser window is well known to those skilled in the art.

*Welter*, col. 7, ll. 9-18. Figure 5 of *Welter* is as follows:





The cited portion of *Welter* describes an example of a web page form that may be tested for errors using the configuration file. *Welter* also provides that "FIG. 5 is a illustration which helps an explain a HTML 'form.'" *Welter*, col. 3, ll. 43-45. Thus, *Welter* discloses a HTML form in order to aid understanding of the context of his invention. *Welter* does not show a *database structure* comprising *functional characteristic fields* as claimed in claim 35, and so does not anticipate claim 35.

#### **II.F Rejection of Claims 36-39**

As shown above, *Welter* does not anticipate claim 35. Thus, *Welter* does not anticipate claims 36-39, at least by virtue of their dependency on claim 35.

#### **III. 35 U.S.C. § 103, Obviousness, claim 33**

The examiner rejects claim 33 under 35 U.S.C. § 103(a) as obvious over *Scarlat et al.*, Service for Load Testing a Transactional Server Over the Internet, U.S. Patent 6,477,483 ("*Scarlet*") in view of *Welter*. This rejection is respectfully traversed.

#### **III.A. The Examiner Has Failed To State a *Prima facie* Obviousness Rejection**

##### **III.A.1 The Proposed Combination Does Not Result in the Claimed Invention**

All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F. 3d 1579, 1582 (Fed Cir. 1994). Regarding claim 33, *Welter* shows none of the features of claim 31, from which claim 33 depends. *Scarlat*, which is directed to load-testing servers, is similarly devoid of disclosure regarding identifying or testing functional characteristics. Thus, the proposed combination does not result in the invention claimed in claim 33. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 33.

##### **III.A.2 The Examiner Has Failed to Provide a Proper Motivation to Combine the References**

In addition, the examiner has failed to state a *prima facie* obviousness rejection because the examiner has failed to state a proper motivation to combine the references. The examiner states that:

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify *Welter* et al. by way of *Scarlat* et al., since companies may not have the time or resources to set up and analyze results; plus, a firm would have the capability service many clients for significant profit.

Office Action of March 9, 2005, p.16.

The statement set forth by the examiner is based on the examiner's motivation rather than that of the prior art. The examiner has failed to point to any teach, suggestion, or inventive in the cited references or elsewhere in the prior art for such a motivation. As a result, the examiner must have used impermissible hindsight to fashion the rejection. Accordingly, the examiner has failed to provide a proper motivation to combine the references.

In addition, the statement cannot be construed to be a motivation to combine the references because the statement only alleges a proposed advantage to combining the references. As a result, again, the proposed advantage is logically insufficient to fulfill the requirement that the examiner provide a proper motivation to combine the references. For example, one of ordinary skill would have to at least recognize the advantage and have a reason to implement it. The examiner's statement does not logically connect the proposed advantage to a proper motivation because the statement does not show how one of ordinary skill would recognize the advantage or have a reason to implement it. Accordingly, the examiner has failed to provide a proper motivation to combine the references and has failed to state a *prima facie* obviousness rejection.

### **III.B. Claim 33 Is Non-Obvious in View of *Welter* and *Scarlat***

In addition, claim 33 is non-obvious in view of *Welter* and *Scarlat* because no one of ordinary skill would be motivated to combine the references. No one would be motivated to combine the references because the references are directed to solving different problems. Both references are directed to subject matter unrelated to each other and to claim 33. *Welter* describes a method for testing HTML code for errors. *Scarlat* describes a method for testing loads on a transaction server over the Internet. Claim 33 claims charging a fee for searching the web site functional characteristics database, in the manner claimed. On their face, *Welter*, *Scarlat*, and claim 33 all solve different problems and are all completely distinct from each other. Thus, one of ordinary skill would have

no reason to combine *Welter* and *Scarlat* and would have no reason to apply either *Welter* or *Scarlat* to claim 33. Hence, when the references are considered as a whole, one of ordinary skill would not combine the references and then further modify the references to achieve the features of claim 33. For similar reasons, no motivation exists to combine the references. Accordingly, claim 33 is non-obvious in view of *Welter* and *Scarlat*.

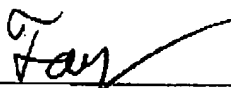
#### IV. Conclusion

It is respectfully urged that the subject application is patentable over *Welter* and *Scarlat* and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: June 8, 2005

Respectfully submitted,



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